the assembly of the audio package is a tool that creates the audio package and exports the audio package to the gateways. The gateway itself does not have to be cognizant of the specific contents of the package other than its format.

In contrast, **Gustman '831** is directed to a system that has a central repository of multimedia files. This system includes a data capture mechanism, an asset management system, and a distribution system. The data capture system transfers analog multimedia material into digital form and catalogs the digital multimedia items. The catalog is used to perform content based searches. The asset management system accesses the data using the catalog, and has an archive server and a tertiary storage manager to store the multimedia content. In addition to the archive server and the tertiary storage managers, a local cache may exist for the asset management system. This local cache is still, however, integrated into the central facilities of the asset management system. Further, this local cache is purged of least used items. The distribution facility is also integrated into the central location and users may request content therethrough. Based on the request of the user, multimedia content is sent to the user and cached on the user's system temporarily. The catalog and index are not sent to the user. How the user stores and uses the information is up to the user. There is no systematic assembly of files exported to users on the network. This reference specifically instructs the interested artisan how Gustman '527 is implemented in its system. Gustman '527 is used only in the data capture portion of the central repository – namely for the purposes of cataloging the data as it is brought into the central repository. *See* Gustman '831, Col. 4, line 30-Col. 6, line 43.

Gustman '527 describes a catalog system for multimedia content that uses an index to access the catalog. The index is created using "phrases" to identify particular pieces of multimedia content. Phrases are described as being a "keyword, person, image, video, (e.g., documentary footage), proposed person, and proposed keyword." Col. 4, lines 15-17. The catalog may be queried to determine content therein meeting the query parameters. The output of such a query is called "a segment," and contains a collection of phrases. Col. 4, lines 29-33.

The **Microsoft Computer Dictionary** defines the term "index," in relevant part, as "[i]n programming and information processing, to locate information stored in a table by adding an offset amount, called the index to the base address of the table." Nowhere in the definition is a length mentioned.

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Response to the rejection under 35 U.S.C. § 101

Claims 22-24 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses. On face, claims 22-24 are directed to a machine (a concrete thing, consisting of parts) – namely a computer readable medium. Computer readable media are recognized as apparatus claims covering floppy disks, CDs, and the like. This is sufficient to satisfy the requirements of 35 U.S.C. § 101. "If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product." *Burr v. Duryee*, 68 U.S. 531, 570 (1863). MPEP § 2106(IV)(B)(2)(a) (citation omitted, see p. 2100-14 of August 2001 MPEP). *See also In re Beauregard*, 53 F.3d 1583, (Fed. Cir. 1995). The Patent Office's refusal to acknowledge that the preamble's apparatus language is sufficient to shift the claim into the realm of statutory subject matter is contrary to the recent decisions of the Federal Circuit. Applicant requests withdrawal of the § 101 rejection at this time.

Response to the rejections under 35 U.S.C. § 103

All of the claims were rejected under 35 U.S.C. § 103 as being obvious over one or more references. For the Patent Office to make out a *prima facie* case of obviousness, the Patent Office must show where in the reference or combination of references each and every claim element may be located. MPEP § 2143.03. If the Patent Office cannot show where each and every claim element may be located within the reference or combination of references, the Patent Office must proffer some motivation to modify the reference or combination of references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

1. Claims 1-11, 13-17, 25-30, 32-36, and 41-44 were rejected under 35 U.S.C. § 103 as being unpatentable over Gustman (831) in view of Gustman (527).

A. Claims 1-8 and 44

In this rejection, the Patent Office focuses on common words that are used in the claim and in the references without analyzing what those words mean in the reference. For example, the Patent Office states that "Gustman [831] further discloses ***an audio database for storing audio segments*** (Gustman [831], Long Term Storage 260, Col. 8, lines 25-34)." (Office Action of 03 October 2002, page 7, lines 2-4, emphasis in original). This may be correct as far as the

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reference is concerned, but this is not the same as "an audio database for storing audio segments *containing announcements to be played to an end user in a network*," which is what is recited in claim 1. The Patent Office admits that the audio segments of the reference do not contain announcements to be played to an end user in a network. (Office Action of 03 October 2002, page 8, lines 9-11). The Patent Office attempts to cure this deficiency by stating that Gustman '831 teaches general multimedia content and that multimedia content includes sound. The Patent Office then opines that "an announcement could be an instance of a phrase 206 as ***an audio segment***." (Office Action of 03 October 2002, page 8, lines 14-15, bold italics in original, underline added). Merely because something could be possible does not mean that there is a requisite teaching or suggestion to support a rejection. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. Absent such a showing, the claim element has not been shown by the combination, and the Patent Office has failed to make a *prima facie* case of obviousness.

While the lack of a database that stores audio segments containing announcements to be played to an end user in a network is sufficient to establish the patentability of claim 1 alone, the Patent Office fails to show other claim elements. The second recited element of claim 1 is an audio package builder/export tool. This tool accesses the audio database to build an audio package including an audio segments file and an index file. The audio segments file contains an audio segment to be played by a gateway in the network. The Patent Office indicates that Gustman '527 "teaches a catalogue as an audio package that [sic] disclosed in figure 18A of Gustman [527]." (Office Action of 03 October 2002, page 7, lines 5-6). Figure 18A does not disclose an audio package, but rather discloses Catalogues A, B, and C, which relate to multimedia data 1802A, 1802B, and 1802C. The Patent Office's flawed interpretation of the reference and its teachings taints the remainder of the Patent Office's discussion of the claim element. The Patent Office states that a "catalogue could be built by using a catalogue element that is referred to as a phrase." (Office Action of 03 October 2002, page 7, lines 6-7). Again, the fact that the Patent Office relies on a conditional term reflects the Patent Office's misapplication of the appropriate standard. Just because something could be modified does not mean that there is any suggestion or motivation to modify the reference to do so.

Further, whether the catalog can be built with phrases is irrelevant to the determination of whether the reference teaches or suggests an audio package builder/export tool. Applicant

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claims a tool that assembles a package that contains an audio segments file and an index file and exports this package to the gateways. The index of the reference is **never** sent anywhere and is only used at the central facility. The fact that a user may receive multimedia content at a remote location is not the same as exporting the audio package that has the index file. The Patent Office has failed to show where the audio package builder/export tool may be found in the reference, much less where it is shown that the index is sent to a remote location.

The Patent Office still further compounds its error when it equates the phrase 206, the segment 204, and the index as the equivalent of the audio segment, the audio segment file, and the index file. (Office Action of 03 October 2002, page 7, lines 12-14). The phrase 206 is defined in the reference as being a "keyword, person, image, video (e.g., documentary footage), proposed person, and proposed keyword." (Gustman '527, Col. 4, lines 14-16). Nowhere in this list is there an indication that a phrase may be an audio segment. Further, the segment 204 is defined as being the output of a query operation that contains a collection of phrases. (Gustman '527, Col. 4, lines 28-33). This is not the same as the claimed audio segments file because a query output that contains persons, images, keywords, proposed persons, video, and proposed keywords is not the same as a file containing audio segments. Thus, these claim elements have not been shown, much less has the audio package builder/export tool that builds the audio package been shown. The Patent Office's only response to this is that "[a] catalogue could be built by using a catalogue element that is referred to as a phrase." (Office Action of 03 October 2002, page 3, lines 20-21). Again, the reliance on the conditional phrase "could be" is fatal to the Patent Office's position. Merely because something could be done is irrelevant. There must be some teaching or suggestion to do so. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

Furthermore, Applicant, in claim 1, recites that the index file contains information usable by the gateway for locating the audio segment in the audio segments file. The index of Gustman '527 has no interrelation with a gateway, and thus, cannot be used by a gateway. This is because Gustman's index is never sent anywhere, but remains on the central facility's machines. The claim element has not been shown.

In short, the combination of references do not show 1) an audio database containing audio segments to be played to an end user in a network; 2) an audio package builder that builds

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an audio package containing audio segments to be played by a gateway; and 3) an audio package builder that builds an audio package containing an index file usable by the gateway. Thus, claim 1 and its dependents 2-8 and 44 are patentable over the rejection of record.

Claim 5 deserves special mention. The Patent Office, in its analysis of claim 5, admits both references fail to teach the destination of the audio package is a plurality of gateways. This confirms Applicant's analysis above with respect to the failure of the reference to teach anything about the claimed gateways. The Patent Office attempts to cure the deficiency by stating that the FTP of Gustman '831 can be used to transfer information to a gateway. (Office Action of 03 October 2002, page 9, lines 15-16). The continued reliance on the conditional does not help the Patent Office's position. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

B. Claims 9-11 and 13-17

Claim 9 recites an audio database for storing audio segments containing announcements to be played to an end user in a network. As explained above, this element is not taught or suggested by the references of record because there is no indication that the multimedia is to be played to an end user in a network. Since this element is not shown or suggested, the claim stands allowable over the rejection of record.

Claim 9 further recites an audio package builder/export tool. This tool allows a user to select from the audio database an audio segment to be played by a gateway. As explained above, and admitted by the Patent Office, the references have no teaching or suggestion concerning the gateway or the export function of the tool that sends the index to the gateway, and thus, these claim elements are not shown or suggested by the rejection of record. Note that the Patent Office admits that the gateway aspect of the claim is still not taught when specifically addressing claim 9. (Office Action of 03 October 2002, page 12, lines 9-10). The Patent Office continues to rely on the possibility that the announcement could be an instance of a phrase. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 10, 11, and 13-17 depend from claim 9 and are patentable at least for the same reasons that claim 9 is patentable.

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C. Claims 25-29

Claim 25 recites "receiving a request from a user for selecting an audio segment containing an announcement to be played by a gateway in a network . . . ." The Patent Office has admitted and continues to admit that the segments of the reference do not contain announcements and that the gateways are not taught. The same is true for the third recited element of "exporting the audio package to a gateway." The Patent Office further continues to rely on the use of conditional possibilities in constructing its rejections. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 26-29 depend from claim 25 and are allowable at least for the same reasons that claim 25 is allowable.

D. Claims 30 and 32-36

Claim 30 recites "exporting the audio package to a gateway." The Patent Office admits and continues to admit that the transfers of the Gustman combination are not to a gateway. The Patent Office opines that the Gustman catalogue *could be* transferred to a gateway. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 32-36 depend from claim 30 and are allowable at least for the same reasons that claim 30 is allowable.

E. Claims 41-43

Applicant herein cancels claims 41-43, thereby mooting the rejection of the same.

2. Claims 22-24 were rejected under 35 U.S.C. § 103 as being unpatentable over Gustman (831).

Claim 22 recites that the data structure comprises "a first section for storing an audio segment containing an announcement . . . ." The Patent Office has previously admitted that the audio of the Gustman reference is not an announcement, and does not provide any analysis for where a suggestion of an announcement can be found. In rejecting this claim, the Patent Office does not discuss the recited claim language "audio segment containing an announcement to be

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played by a gateway in the network." Thus, this claim element is not taught or suggested, and the claim defines over the reference for this reason alone.

Further, claim 22 recites that the second section indicates the number of audio segments in the first section. The Patent Office admits that this element is not taught or suggested by the reference. (Office Action of 03 October 2002, page 25, lines 7-8). The Patent Office attempts to address this deficiency by stating that the attribute elements of Gustman '831 are the same as an indication of the number of audio segments. More specifically, the Patent Office states "a count to indicate the number of audio segments in the first section can be added to the attribute elements." (Office Action of 03 October 2002, page 25, lines 9-10). As Applicant has previously stated, possibilities are not sufficient to support a rejection. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 23 and 24 depend from claim 22 and are allowable for at least the same reasons that claim 22 is allowable.

3. Claims 37-40 and 45-46 were rejected under 35 U.S.C. § 103 as being unpatentable over Gustman (831) in view of Gustman (527) and Microsoft Corporation Dictionary.

A. Claims 37-40

Claim 37 recites that the audio package definition contains information sufficient to allow creation of a first audio package containing audio to be played on a gateway. As explained above, the combination of Gustman references does not teach or suggest the gateway. The Patent Office has admitted this. The Patent Office's only response to this position is that the references could be used in the manner claimed. This is insufficient. The Patent Office is obligated to show where the motivation to use the reference in this manner is located. As this motivation is completely lacking, the Patent Office has failed to make a *prima facie* case of obviousness.

Claim 37 further recites that the index file includes an offset and a length usable by the gateway. The Patent Office admits that both Gustman references fail to teach this element and points to the Microsoft dictionary reference to fill the void. However, the definition provided by the Microsoft dictionary has no mention of a length. The statement that the Microsoft dictionary mentions length is demonstrably false by an examination of the definitions provided in the

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dictionary reference. Thus, this element is also not taught or suggested by the reference of record. The Patent Office's statement that the Gustman '831 and Gustman '527 index file should have an offset and a length by default is clearly in error. This is especially true when the following fact is considered: Gustman's index file and its contents are specifically defined – and make no mention of an offset or a length, but rather focus on the fact that the index is built on the attributes and attribute elements (Gustman '527, Col. 4, lines 20-23). There is never a suggestion of offsets or lengths.

Since the Patent Office has failed to show where the claim elements are in the combination, the Patent Office has failed to make a *prima facie* case of obviousness, and claim 37 is allowable over the rejection of record.

Claims 38-40 depend from allowable claim 37 and are allowable for at least the same reasons that claim 37 is allowable.

B. Claims 45 and 46

Claim 45 recites many elements that have already been discussed and argued. Specifically, the first element contains the announcement limitation that the Patent Office admits is not in the references. The second element recites that the audio segments are to be played by the gateway. The Patent Office admits that the references do no teach or suggest the gateways. The second element has a subelement of the index file with the length and offset. As explained above, the Microsoft dictionary does not teach or suggest the length. The third element of the claim recites exporting the audio package to the gateway. Again, this element has been previously discussed. The Patent Office provides no new analysis to rebut these arguments, and thus, claim 45 defines over the rejection of record.

Claim 46 depends from allowable claim 45 and is allowable for at least the same reasons that claim 45 is allowable.

The Patent Office has failed to show where in the references the claim elements are taught or suggested. The Patent Office attempts to cure these problems by asserting that it is possible to use the combination of references in the manner claimed. However, absent a suggestion or motivation to modify the combination, the Patent Office cannot rely on such hypothetical situations because such hypothetical situations are invariably constructed using impermissible hindsight. For these reasons, the claims define over the rejection of record.

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Applicant requests reconsideration of the patentability of the claims at the Examiner's earliest convenience.

Respectfully submitted,

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